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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,169	01/21/2004	Loretta E. Allen	84196B/F-P	3766

7590 05/31/2006
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EXAMINER

NGUYEN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/762,169

Applicant(s)

ALLEN ET AL.

Examiner

Kimberly D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Acknowledgment is made of Amendment filed March 3, 2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Soscia (US 6,636,332).

Soscia teaches a method of providing a machine-readable indicia (40) on a media having a protective overlayer comprising the steps of

providing a first machine-readable indicia (image 20 of a subject 30, wherein the subject 30 may be a human subject, an inanimate object or alpha-numeric lettering (column 3, lines 23-30); image 20, which is captured by digital camera 119 (column 4, lines 47-49), which is machine-readable) in an image layer on the media (50; e.g., the image 20, which is printed on a first recording medium 50 (column 4, lines 20-22)); and

providing a second machine-readable indicia (40, which is preferably in the form of a two-dimensional encoded variable... (column 3, lines 48-52; column 5, lines 53-57; column 5, lines 48-51)) in a protective overlayer (100) that is identical in content to (the indicia 40, which is digitally representing image 20 (column 3, lines 34-38)), and in register with the first machine-

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readable indicia in the image layer (the indicia 40, which is imprinted onto any desired portion of the original image 20 or may be appended to image 20 (column 3, lines 34-38)) (column 3, line 15 through column 5, line 66).

Response to Arguments

4. Applicant's arguments filed March 3, 2006 have been fully considered but they are not persuasive.

5. In response to applicants' argument that

“Soscia fails to teach or suggest at least providing a second machine-readable indicia in a protective overlayer that is identical in content to, and in register with said first machine-readable indicia in said image layer as required by independent claims 1 and 2...” (page 3, lines 8-21)

Soscia teaches the two-dimensional encoded indicia 40, which digitally represents the image 20 and, is printed onto any desired portion of the image 20 (col. 5, lines 34-38 and lines 48-52) or laid-down over image 20 (col. 4, lines 5-6), which certainly the indicia 40 is identical in content to, and in register with the first indicia 20.

6. In response to applicants' argument that

“Second, Soscia does not even provide machine-readable indicia in a protective layer. Rather, Soscia discloses that the image 20 includes first, second and third colorant layers 70/80/90, a fourth layer 100 including an indicia 40 overlaying the third colorant layer 90, and a fifth clear protective layer 110 for protecting the fourth layer 100 (including indicia 40) from damage. See Col. 4, lines 20-41; Fig. 4; Col. 5, lines 45-51. Accordingly, the indicia 40 of Soscia is not in a protective layer.” (page 3, lines 22+)

The examiner respectfully disagrees. Soscia teaches the indicia 40 is made of invisible dye in order to preserve fidelity and aesthetic enjoyment of image 20 (col. 4, lines 5-19). The indicia 40 overlays the image 20 without interfering with the visual enjoyment of image 20

because indicia 40 is formed in fourth layer 100 as an invisible colorant (col. 5, lines 48-51).

Accordingly, the indicia 40 is in a protective layer.

7. In response to applicants' argument that

“Also, Soscia fails to teach or suggest at least providing a first machine-readable indicia in an image layer on said media. Rather, Soscia discloses an image 20 includes first, second and third colorant layers 70/80/90. Soscia does not disclose that image 20 is machine-readable.” (page 3, last 4 lines)

Soscia teaches the image 20 of subject 30, wherein the subject 30 may be human subject as shown in figure 1, an inanimate object or alpha-numeric lettering (col. 3, lines 23-38); wherein the image 20 of subject 30 is read/captured by the camera 119 (col. 4, lines 47-64). Accordingly, the image 20 is a machine-readable.

Soscia also teaches the image 20 which is printed on a first recording medium 50 (col. 4, lines 20-22). Thus, the image 20 is a machine-readable indicia in an image layer as set forth in the claim. Accordingly, given its broadest reasonable interpretation, Soscia meets the claimed invention.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402.

The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



KDN

May 23, 2006